

REMARKS

Claims 1-26 are pending in the application. Upon entry of this Amendment, claims 1, 4, 8, 10, 11, 15, and 17 will be amended, and new claims 27 to 50 will be added.

Claims 4 and 11 have been amended to correct some typographical errors and change their dependency so that the several elements recited in each of these claims now have proper antecedent bases. Specifically, claim 4 has been amended to depend from dependent claim 3, rather than independent claim 1, while claim 11 has been amended to dependent from dependent claim 10, rather than independent claim 8. Claims 1, 8, 10, 15 and 17 have been amended to also correct some typographical errors.

The application specification has been amended to clarify that a product displayed on a catalog page can be a plurality of items that have been grouped together for presentation in a catalog, as shown, for example, in FIGURES 5 and 7 of the application. It is believed that no new matter has been added to the application by this amendment to the application specification because the amendment describes what is shown in Figures 5 and 7 of the application.

In the outstanding Office Action of December 18, 2003, the Examiner rejected claims 1-26 under 35 U.S.C. §103(a) as being unpatentable over Escallon (U.S. Patent No. 5,799,157) in view of Westrope *et al.* (U.S. Patent No. 5,721,832). The Examiner's rejection is respectfully traversed.

For a claimed invention to be obvious over a combination of prior art references, there must be some suggestion, motivation, or teaching in the prior art that would have led one of ordinary skill in the art to combine the references to produce the claimed invention. *E.g.*, Ashland Oil, Inc. v. Delta Resins & Refracs., 776 F.2d 281, 293 (Fed. Cir. 1985). Here, the claimed invention of the present application is not obvious over the cited references for at least two reasons.

First, the Examiner has failed to point to any evidence of any suggestion, motivation, or teaching in the prior art to combine the cited references; and, second, the Escallon and Westrope *et al.* prior art references relied upon by the Examiner in his §103(a) rejection do not disclose or suggest at least two of the limitations of the claimed invention so that, even if such references were combined, the resulting combination would still not be the claimed invention.

Independent claims 1, 8, 15 and 19 of the present application each recite (a) storing in a first device, for each page of a product catalog, a file containing a low resolution scan of the catalog page, and (b) storing in the first device, for each

product displayed on the low resolution scan of the catalog page, a plurality of files from which a detailed presentation of the product is prepared. Neither Escallon nor Westrope *et al.* discloses or suggests these elements of the claimed invention.

Escallon discloses a system and method for creating a system for the presentation of information and processing of transactions based upon such information. Escallon's system includes a production system for compiling and coding an electronic book, including information presentation pages, databases associated with the presentation pages, and coded forms for receiving and formulating transaction requests based upon such information. Escallon, col. 1, lns. 10-17. There are three main interactive components in Escallon's system, *i.e.*, (1) client computers 100, which function as front end user interfaces through which front end users access and interact with the two other main components of the system; (2) a transaction management system 200, connectible by a communications link 110 to the client computers 100, through which data presentations and transactions are executable, and (3) transactional databases 300 accessible by the transaction management system 200 through a communications link 210. As shown in Fig. 1, the electronic book production system is resident on the client computers 100, and is separate from the transaction management system 200 and the transactional data bases 300. Where the electric book 120 is used for the electronic presentation of any printed text, Escallon teaches that the data may

include a cover page, table of contents pages, and individual pages of course presenting information relating to entries on the table of contents pages. Where the electric book 120 is used specifically as an electronic catalog, Escallon teaches that "there may similarly be compiled for sequential or selected display a cover page 24, table of contents page(s) 126 and individual pages 128 dedicated to individual products or similar types of products." Escallon, col. 3, lns. 26-36.

At page 3 of the outstanding Office Action, the Examiner admits, in effect, that Escallon does not teach storing in a first device a low resolution scan of each catalog page or, for each product displayed on the low resolution scan of the catalog page, storing in the first same device a plurality of files from which a detailed presentation of the product is prepared, as recite in independent claims 1, 8, 15, and 19. Nor does Escallon, in its example of an electronic product catalog, disclose a detailed product presentation that is requested from a low resolution scan of a catalog page and that includes a high resolution image of the product, a headline file identifying the product, a copy file containing a description of the product, and an order block data file containing ordering information for purchasing the product, as recited, for example, in dependent claims 3, 10 and 17 of the present application.

To overcome the deficiencies in the teachings of the Escallon reference, the Examiner first looks to the Westrope *et al.* reference as teaching that electronic catalog data can be digitized in a data entry system comprising a document scanner that can be used to capture catalog images. *See*, Office Action, p. 3. Westrope *et al.* disclose a computerized catalog system by which a customer can selectively access video and audio catalog data from a computerized catalog memory that permits the customer to peruse an entire catalog of products or services or select specific portions from specific catalogs or services and, if desired, place an order which is processed by the system. But even if Westrope *et al.* teach digitizing electronic catalog data in a data entry system which may comprise a document scanner or encoder for converting graphic data into digital video data that is stored in memory, as argued by the Examiner, like Escallon, Westrope *et al.* do not teach storing in a first device a low resolution scan of each catalog page or, for each product displayed on the low resolution scan of the catalog page, storing in the first same device a plurality of files from which a detailed presentation of the product is prepared, as recite in independent claims 1, 8, 15, and 19. The Examiner acknowledges as much by taking "official notice" that "it is old and well known in the art to use thumbnail graphics (low resolution) on table of content pages and then based on a selection by the user to send larger (high resolution) images with detailed information in order to decrease download times." Office Action, p. 3.

While it may, in limited circumstances, be appropriate for an examiner to take official notice of "commonly known facts" in considering the patentability of an invention, *see* MPEP §2144.03, it is not appropriate for an examiner to use his or her own understanding or experience of what would be "basic knowledge or common sense" when making "core factual findings" for a patentability determination of a claimed invention. Rather, the examiner must rely on "concrete factual evidence" to support a rejection of the claimed invention. *See, In re Zurko*, 258 Fed.3d 1379, 1385-86 (Fed. Cir. 2001).

In this case, the *Zurko* decision requires the Examiner to provide concrete factual evidence regarding the use of low resolution scans in the manner argued by him to support his determination that claims 1-26 are not patentable because they are obviousness over the cited prior art. Relying on official notice is inappropriate.

In *Zurko*, the claimed invention was directed to a method for more efficiently creating a secure or "trusted" computer environment. The Examiner rejected the claimed invention under 35 U.S.C. §103, relying on a combination of two prior art references, *i.e.*, the UNIX Operating System ("UNIX") and a program (Dunford, FILER Version 2.20 ("FILER 2")) for repeating potentially dangerous commands before execution. In sustaining the rejection, the Patent Office Board of Appeals "contended that even if the cited UNIX and FILER 2 references did not

disclose a trusted path, 'it is basic knowledge that communication in trusted environments is performed over trusted paths' and, moreover, verifying the trusted command in UNIX over a trusted path is 'nothing more than good common sense.'" Zurko, 258 F.3d at 1385. On appeal, the Federal Circuit rejected the Board's contentions, holding:

This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.

Zurko, 258 F.3d at 1385-86. (Emphasis added). The same is true with respect to the Examiner's rejection of pending claims 1-26 under §103(a) as being obvious over Escallon in view of Westrope *et al.* Thus, it is not proper for the Examiner to rely on "official notice" regarding low resolution scans to support his §103(a) rejection of claims 1-26. A copy of the *Zurko* decision is attached for the Examiner's convenience.

But, even assuming, *arguendo*, that the Examiner properly took "official notice" in his rejection of claims 1-26, the "fact" of which the Examiner has taken official notice still does not, when combined with the cited references, result in the claimed invention of the present application. In the claimed invention, "thumbnail graphics (low resolution) on table of contents pages" are not used. Rather, in the claimed invention, for each page of a product catalog, there is stored in a first device a file containing a low resolution scan of the catalog page, and for each product displayed on the low resolution scan page, there is also stored in the first device a plurality of files from which a detailed presentation of the product is prepared. In a preferred embodiment of the invention, the detailed product presentation includes a file containing a high resolution image of the product, a headline file identifying the product, a copy file containing a description of the product, and an order block data file containing ordering information for purchasing the product. These elements of the claimed invention are not disclosed in the cited references, and, thus, the claimed invention is not obvious over the cited prior art.

In view of the foregoing, it is now believed that all of the claims pending in the application, *i.e.*, claims 1-50, are now in condition for allowance, which action

is earnestly solicited. If any issues remain in this application, the Examiner is urged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: Robert A. Molan
Robert A. Molan
Reg. No. 29,834

RAM:drt
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100